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## RE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.0633-00

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Application Number

09/648,376

Filed

August 25, 2000

First Named Inventor

David W. Cannell

Art Unit

1617

Examiner

S. Wang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Deborah M. Herzfeld  
Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Deborah M. Herzfeld

Typed or printed name

attorney or agent of record.

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

December 6, 2005  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Customer No. 22,852  
Attorney Docket No. 05725.0633  
Application No.: 09/648,376

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
David W. CANNELL et al. ) Group Art Unit: 1617  
Application No.: 09/648,376 ) Examiner: Wang, Shengjun  
Filed: August 25, 2000 )  
For: PROTECTION OF KERATINOUS ) Confirmation No. 5418  
FIBERS USING CERAMIDES )  
AND/OR GLYCOCERAMIDES )

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Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In reply to the Final Office Action dated August 11, 2005, and pursuant to the July 12, 2005 OG Notice regarding the Pre-Appeal Conference Pilot Program, Applicants respectfully request panel review of the outstanding final rejection under 35 U.S.C. § 103(a) identified in the Remarks below. This Request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, appeal fee payment, and completed form PTO/SB/33. No amendments are being filed with this Request.

**REMARKS**

Claims 1-12, 16-36, 38-40, 44-50 and 53 are pending in this application. Claims 4 and 27-40 and 44-49 have been withdrawn from consideration by the Examiner. Claims 1-3, 5-12, 16-26, 50, and 53 are under consideration and stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,799,456 ("Dubief") in view of U.S. Patent No. 5,656,258 ("Cauwet") and U.S. Patent No. 5,958,392 ("Grollier"). Final Office Action at 2.

Applicants respectfully submit that this rejection is in error and should be withdrawn because the Examiner has not established a *prima facie* showing of obviousness. In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must at least teach or suggest all of the claim limitations **and** must provide a suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine references. See M.P.E.P. § 2143.

In particular, all three references combined do not teach or suggest all of the present claim limitations, as required for a showing of obviousness. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The present claims recite a composition comprising, among other things, at least one cationic polymer and at least one amphoteric polymer (such as polyquaternium-22), “wherein the weight ratio of said at least one cationic polymer to said at least one amphoteric polymer is greater than or equal to 3:1.” See, e.g., claim 1.

The Examiner cites *Dubief* for teaching a composition comprising “ceramide compounds and a cationic polymer” and has admitted that *Dubief* does not teach polyquaternium-22. Final Office Action at 2. The Examiner asserts that *Grollier* “teaches the employment of a combination of cationic polymer and amphoteric polymer in hair cosmetic composition. Such combination has over come many disadvantages of compositions using cationic polymer alone or using other combination.” *Id.* at 3 (citing *Grollier* at col. 1, lines 16-59). *Grollier* also does not teach the use of polyquaternium-22. Finally, the Examiner asserts that *Cauwet* “teaches that polyquaternium-22, or MERQUAT 280 is a known amphoteric copolymer of acrylic acid and dialkylaminoalkyl acrylamide, and is particularly useful in hair treating composition with cation [sic] polymers.” *Id.* (citing *Cauwet* at col. 1, line 49 to col. 2, line 65; col. 3, lines 1-38; col. 6, lines 10-28). However, *Cauwet* expressly teaches that the weight ratio of its at least one quaternary polyammonium polymer (a) to its at least one polymer (b) containing diallyldialkylammonium units be less than 1. See, e.g., the Abstract of *Cauwet*. Thus, there is no teaching of at least one amphoteric polymer chosen from polyquaternium-22 wherein the

weight ratio of said at least one cationic polymer to said at least one amphoteric polymer is greater than or equal to 3:1. See, e.g., Claim 1.

Further, the Examiner has not shown any suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the cited references to arrive at the present claims. The Examiner concludes that "it would have been *prima facie* obvious to a person of ordinary skill in the art at the time the claimed invention was made, to employ a combination of the cation[ic] polymer and the amphoteric polymer herein Dubief composition." Final Office Action at 3.

The Examiner supports this conclusion by ignoring the limitation that "the weight ratio of said at least one cationic polymer to said at least one amphoteric polymer is greater than or equal to 3:1." See, e.g., Claim 1. The Examiner contends that both *Grollier* and *Cauwet* "teaches [sic] the benefits of the combination of cationic polymer and amphoteric polymers, and both [sic] teach a broad range of the ratio of the polymers." *Id.* at 4. The Examiner further concludes it "is well settled that in the case where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a *prima facie* case of obviousness exists." *Id.* (citations omitted). Applicants respectfully disagree with the Examiner both factually and legally.

First, the broad range of ratios disclosed in *Grollier* would not teach or suggest to one of ordinary skill in the art that the ratio of cationic polymers to amphoteric polymers is a result-effective parameter, and thus would not provide motivation, especially in combination with *Dubief* and *Cauwet*, to create a composition with the claimed ratio. See *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Moreover, *Grollier*'s range is so broad that it is analogous to a genus that does not render the species obvious. See *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (Fed. Cir. 2003). Thus, the Examiner's contention that "it is well settled" that a broad range (e.g., the ratio of 10:1 to 1:10 in *Grollier* claim 16, cited by the Examiner in the Final Office Action at 5) encompassing one point (e.g. the claimed ratio 3:1) establishes a *prima facie*

showing of obviousness is factually and legally incorrect. See *In re Baird*, 16 F.3d 380, 29 USPQ 1550 (Fed. Cir. 1994).

Second, this is not a case where the claimed ranges overlap or lie inside the ranges disclosed by the art. Rather, the entire teaching of *Cauwet* is of cationic polymers in combination with at least one amphoteric polymer **in a ratio no greater than 1.5 to 1** and more specifically, where at least one amphoteric polymer is chosen from polyquaternium-22. See, e.g., *Cauwet* abstract. By disclosing such a ratio, *Cauwet* is teaching that the weight content of cationic polymers needs to be **equal to or less than** amphoteric polymers. Thus, *Cauwet* teaches away from the present claims, which require that the weight ratio of the at least one cationic polymer to the at least one amphoteric polymer is greater than or equal to 3:1, i.e., the weight content of cationic polymers is **greater than** amphoteric polymers.

The Examiner attempts to rebut this argument by citing the claim language in *Cauwet*, which is any “synergistic combination” of cationic to amphoteric polymer. The claim language does not change the fact that the specification of *Cauwet* teaches to one of ordinary skill in the art that a “synergistic combination” is a ratio of cationic to amphoteric polymer **no greater than** 1.5 to 1. See *Cauwet* specification at col. 1, lines 49-53 (“It has been discovered that the combination of certain conditioning polymers . . . when they are used in a given ratio make it possible to overcome these disadvantages due to a synergistic effect that is achieved.”). See also *Cauwet* Examples.

The Examiner cannot merely rely on *Cauwet*’s claim language and its teaching of amphoteric polymers, and ignore the amount of amphoteric polymers taught throughout the specification. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). Moreover, any attempt to cure the teaching away would be fundamentally improper as it would destroy the inventive nature of *Cauwet*. See *In re Laskowski*, 871 F.2d 115, 10 USPQ 2d 1397 (Fed. Cir.

1989) (holding that it is improper to combine references if their combination would result in the destruction of the intended operation or if a reference teaches away from the claimed invention).

Accordingly, one of ordinary skill in the art would not be motivated to combine the teachings of *Dubief*, *Grollier* and *Cauwet* in order to create the presently claimed invention. The Examiner has failed to make particular findings as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components of the claimed invention for combination in the manner claimed. See *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 1998).

Thus, for at least the foregoing reasons, the rejection is improper and Applicants respectfully request that it be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: Deborah M. Herzfeld  
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Date: December 6, 2005